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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/607,604 | 06/27/2003 | Kobi Richter | 4396-4001 | 7611 |
| 27123 | 7590 | 12/12/2005 | EXAMINER | |
| MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | CHATTOPADHYAY, URMI | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3738 | |
| DATE MAILED: 12/12/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/607,604 | Applicant(s) RICHTER, KOBI | |
| | Examiner Urmi Chattopadhyay | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 4-30, 32-36 and 44-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 31, 37-43, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Response to Notice of Non-Compliant Amendment filed 9/15/05 has been entered. The changes to the claims have been approved by the examiner, and new claims 48 and 49 have been added. Claims 1-49 are currently pending, of which claims 4-30, 32-36 and 44-47 remain withdrawn from consideration for being drawn to a non-elected species. The claims being considered for further examination on the merits are claims 1-3, 31, 37-43, 48 and 49.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 48 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 48 is indefinite because it requires the amorphous metal alloy to be selected from the group consisting of silicon, boron, and phosphorous. According to the specification on page 5, lines 18-25 (paragraph [0020]), amorphous metal alloys may comprise a metalloid, and the examples of metalloids are given as silicon, boron and phosphorous. Because claim 1, on which claim 48 depends, only requires the copper-based alloy to have a metalloid, it is unclear how an iron-based or cobalt-based metal alloy would be further limited by claim 48. Is claim 48

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further limiting any one of the alloys of claim 1 to further have a metalloid, which is selected from silicon, boron or phosphorous?

4. Claim 49 is indefinite because it is not commensurate with claim 1, on which claim 49 depends. How can the amorphous metal alloy be an Fe-Cr-B-P alloy when it has already been limited to a copper-based or cobalt-based alloy?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 31 is rejected under 35 U.S.C. 102(e) as being anticipated by Horton, Jr. et al. (USPAP 2002/0162605 A1, as cited in previous office action).

Horton, Jr. et al. disclose a stent with all the elements of claim 31. See [0008]-[0010] and [0036] for an implantable medical device comprising an amorphous metal alloy. See claims 8 and 9 for the device being a stent comprising a tube comprising an amorphous metal alloy.

7. Claims 1-3, 37-43, 48 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaufman et al. (USPAP 2004/0072124 A1).

Kaufman et al. disclose a medical device with all the elements of claims 1, 37 and 41. See paragraph [0012] for a medical implant comprising an amorphous metal alloy having a

composition represented by the general formula $X_aM_bAl_c$, wherein X is Zr or Hf, M is selected from the group consisting of Mn, Fe, Co, Ni, Ti and Cu, and a, b, and c are $25 < a < 85$, $5 < b < 70$ and $0 < c < 35$ in atomic percentages. In an embodiment where M is Co of a high atomic percentage, the amorphous metal alloy will be a cobalt-based alloy. Claims 37 and 41 are product-by-process claims, and according to MPEP § 2113, these claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. The patentability of a product does not depend on its method of production, but on the product itself. Because Kaufman et al. meets the structural limitations of claims 37 and 41 of a medical device containing a cobalt-based amorphous metal alloy, the claims are properly rejected thereby.

Claims 2 and 3, see [0012] and [0019] for a medical “implant”, which is by definition capable of being permanently or temporarily implanted.

Claims 38-40 and 42-43 are product-by-process claims. They do not structurally further limit the claimed invention. See rejection to claims 37 and 41, supra.

Claims 48 and 49 do not further structurally limit the claimed invention because the cobalt-based alloy is not required to include a metalloid, and therefore is not required to include silicon, boron or phosphorous. Also, a cobalt-based amorphous metal alloy cannot be an Fe-Cr-B-P alloy, as required by claim 49. See 112, second paragraph rejection, supra.

Response to Arguments

8. Applicant's arguments with respect to claims 1-3 and 37-43 have been considered but are moot in view of the new ground(s) of rejection. Applicant neither amended claim 31 nor

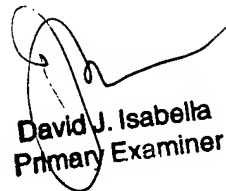
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presented arguments with respect to the merits of rejection of claim 31. Therefore, the rejection of claim 31 is maintained.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


David J. Isabella
Primary Examiner

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Urmi Chattopadhyay', with a stylized flourish at the end.

Urmi Chattopadhyay

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